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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/476,319 12/30/99 HASEBE

T P21-9028

EXAMINER

LM02/0519

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BARRON JR, G

ART UNIT

PAPER NUMBER

2767

3

DATE MAILED:

05/19/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/476,319

Applicant(s)

Hasebe et al.

Examiner

Gilberto Barron Jr.

Group Art Unit

2767



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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*Reissue Applications*

1. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

In statement #9: A proper statement must state "All errors being corrected...". See 37 CFR(a)(2).

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In opening statement "...residing at c/o Fijitsu Limited..." is not a proper designation of residence.

In statement #8 "The above amendments to the claims.." There are no amendments to the claims.

3. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

4. Claims 1-18 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 6-7, 11-12 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Matyas (4,757,534 hereinafter as '534).

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The '534 patent discloses a software protection system for a storage medium (a diskette) accessed by a storage readable apparatus (a user computer). The protection system provides for a medium personal number unique to each storage medium written onto the storage medium in an un-rewritable form which a user storage readable apparatus cannot rewrite. See Figure 2 and 7 of '534 where the computer password (formed from the program and diskette serial number, see col. 5, lines 30-37) is indicated as "rewrite/overwrite not permitted by software". The computer password allows for generating a decryption key for decrypting the encrypted electronic data (as in claims 1-2) or generating an encrypted permission information (as in claims 6-7 and 11-12) or for decrypting the encrypted electronic information which is encrypted based on the medium personal number (as in claims 17 and 18).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5, 8-10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas (4,757,534) in view of Shear (4,827,508 hereinafter '508).

The '534 patent discloses a diskette as the storage medium while the instant claims provide for optical disks and/or cd-ROMS. The Shear '508 patent teaches a security system for

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metering the usage and billing for the use of a digital database. The digital database is provided on an optical disk or a cd-rom, see col. 2, lines 29-57. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an optical disk or cd-rom as taught in Shear '508 for the diskette of Matyas '534 in order to store large amounts of information for distribution to various users. Shear also teaches using different coding for different files stored on the medium, see col. 15, lines 51-62. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide plural encrypted data each having different coding as taught in Shear '508 in the storage medium of Matyas '534 in order to protect the electronic data according to different uses and/or payment types.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Tod Swann, can be reached on (703) 308-7791. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3800/4700.



GILBERTO BARRÓN, JR.  
PRIMARY EXAMINER  
ART UNIT 222-2767